

REMARKS

The Office Action repeatedly refused to give any recitations in the preambles of claims 1-8 any patentable weight. Applicant submits that this is clearly improper in this case. The Office Action paid lip service to the law on this area by providing a passing citation to the controlling case, *Kropa v. Robie*, 187 F.2d 150; 88 U.S.P.Q. 478 (C.C.P.A. 1951). Applicant here provides the entire relevant portion of *Kropa* where the “life, meaning, and vitality to the claims” language was used.

This court has often had before it the Jepson problem (243 O.G. 525--1917)--whether the preamble to claims in ex parte cases or to the counts in interference cases should be considered as limitations in the claims or counts. Of the thirty-seven cases of this court we have reviewed with respect to this problem it appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause; or where the claim or count was drawn to a product and the introductory clause merely recited a property inherent in the old composition defined by the remaining part of the claim. In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter. On the other hand, in those ex parte and interference cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over the prior art.

Kropa at 152.

The Federal Circuit has acknowledged the well-settled nature of *Kropa*.

We construe claim preambles, like all other claim language, consistently with these principles. Much ink has, of course, been consumed in debates regarding when and to what extent claim preambles limit the scope of the claims in which they appear. ... These debates center, however, on particular arts and claiming styles and do not call into doubt the general principle, as well-settled as any in our patent law precedent, that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.

Bell Research, Inc. v. Vitalink Comm. Corp., 55 F.3d 615, 620; 34 U.S.P.Q.2d 1816 (Fed. Cir. 1995)

A good description of the test is given in *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298; 51 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Here, the preamble is "necessary to give life, meaning, and vitality" to the claim. *Kropa*, 187 F.2d at 152, 88 U.S.P.Q. (BNA) at 480-81. The preamble statement that the patent claims a method of or apparatus for "producing on a photoreceptor an image of generated shapes made up of spots" is not merely a statement describing the invention's intended field of use. Instead, that statement is intimately meshed with the ensuing language in the claim.

Pitney Bowes at 1306.

Applying the law as clearly expressed above to claim 1 indicates that at least portions of the preamble must be treated as limitations. Metal blade seals are not new. What is new is the use of metal blade seals on a seal retainer for an undersea hydraulic coupling member. The statement describing the location of the blade seals ("on a seal retainer") and the type of seal retainer ("for an undersea hydraulic coupling member") is essential to give meaning to the claim and should not be disregarded in testing the claim against the prior art.

The Office Action rejected claims 1 and 2 under §102(b) as being anticipated by U.S. Patent No. 1,178,714 (“Griffin”). The Office Action contends that the projections which define channel 9 in the pipes joint of Griffin comprise metal blade seals that engage with a female coupling member (A). This is incorrect.

The projections on tongue 8 which define channel or depression 9 in part B of the pipe joint do not engage part A. Instead, they engage gasket “g”. “It follows when the said gaskets are placed in position and the coupling members are tightened on each other that the gaskets are not only compressed into the said comparatively narrow channels in both groove 5 and tongue 8, but the rather sharply defined walls of said channels form sealing portions which prevent the fluid from possibly creeping laterally past or through the gaskets.” [page 1; lines 80-89]

Claim 1, as amended, requires the blade seals to engage a metal surface within a female coupling member. This requirement is not met in the pipe coupling described in Griffin.

Claim 2 requires an elastomeric seal contained between metal blade seals. This requirement is also not met in the pipe coupling described in Griffin. “That is, with gaskets of the width shown and a comparatively narrow edge on the tongue 8 the gasket is compressed both within and without the channel 9 of the tongue and at the angles of the shoulders 7.” [page 1; lines 90-94] Thus, the gasket is not “contained between metal blade seals” as required by claim 2.

The Office Action rejected claims 1-4 under §102(b) as being anticipated by U.S. Patent No. 4,022,262 (“Gunn”). The Office Action contends that Gunn discloses a seal retainer for an undersea hydraulic coupling member comprising metal blade seals (16) that engage with a female coupling member (26).

Gunn describes a locknut “of the type commonly used for securing a conduit to an electrical junction box.” [abstract] Gunn has nothing to do with hydraulic coupling members. Gunn does not describe blade seals. Rather, the locknut has “a plurality of angular prongs or teeth about the circumference thereof adapted to bite into the metal of the junction box to obtain a good ground connection.” [abstract] As may be seen in

Figure 2 of Gunn, these teeth about the circumference are discontinuous. Thus, no seal is formed. For sealing, Gunn relies on a ring 18 “of plastic or other suitable material disposed on the side of the locknut on which the angular teeth project.” This elastomeric seal is not contained between metal blade seals as required by claim 2. There is no shoulder in a female member for the blade seal to cut into as required by claim 3 and no metal-to-metal seal is formed as required by claim 4. Accordingly, Gunn does not anticipate claims 1-4.

The Office Action rejected claims 1, 2 and 4-8 under §102(b) as being anticipated by U.S. Patent No. 612,455 (“Gore”). The Office Action contends that rib 8 of Gore with its inner and outer surfaces comprise metal blade seals that engage with a female coupling member (2). Applicant traverses this contention.

By necessity, blade seals are sharp and thin to enable them to cut into an opposing surface and/or be deflected by an adjoining surface. The massive and blunt ring 8 in the pipe-flange coupling of Gore is nothing like a blade seal. Because it does not form a seal, the coupling of Gore must employ flexible packing ring 13 on top of rib 8 in order to effect a seal.

Claim 2 and claim 8 require an elastomeric seal contained between metal blade seals. Gore does not describe an elastomeric seal and, in the pipe flange coupling of Gore, there is only a single ring. Thus, there is no defined space “between metal blade seals” within which an elastomeric seal could be contained.

Claims 4-8 require a seal retainer and, as noted above, all the claims require an hydraulic coupling member. The pipe flange of Gore does not have a seal retainer and Gore does not describe an hydraulic coupling member. For this reason and the reasons stated above, Gore does not anticipate claims 1, 2 and 4-8.

The Office Action rejected claims 1 and 4-7 under §102(b) as being anticipated by U.S. Patent No. 5,370,153 (“Galle”). The Office Action contends that Galle discloses a seal retainer for an undersea hydraulic coupling member comprising metal blade seals (48) that engage with a female coupling member (12).

The hydraulic coupling of Galle has no seal retainer as required by claims 1 and 4 – 7. Moreover, as noted above, blade seals are thin and sharp. Sealing wedge 48 of Galle is thick and blunt (note rim 50 in Figure 2) and therefore would not be considered a blade seal by one skilled in the art. Figure 3 is said to be an enlarged partial sectional view of the seal of Figure 1 shown in a connected position. [col. 2; lines 10-12] It will noted that rim 50 does not contact or cut into surface 34 when the coupling members are connected. Accordingly wedge 48 is not a blade seal and thus Galle does not anticipate claim 1.

Newly added claims 9 – 20 include the elements of a seal retainer insertable into the bore of a female undersea hydraulic coupling member. These elements correspond to those in the allowed claims of patent application serial number 10/285,062 “Undersea hydraulic coupling with seal retainer” by Applicant and assigned to the same entity as the subject case.

For the reasons discussed above, it is submitted that the claims, as amended, are in condition for allowance. Reconsideration of the rejection is requested.

Respectfully submitted:



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